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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,084	11/19/2003	Christopher J. Cookson	3053-066	9419

22440 7590 06/05/2006

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EXAMINER	
PSITOS, ARISTOTELIS M	

ART UNIT	PAPER NUMBER
2627	

DATE MAILED: 06/05/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/718,084	COOKSON ET AL.	
	Examiner	Art Unit	
	Aristotelis M. Psitos	2627	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *19 November 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-16* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-16* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

The IDS filed on 8/4/05 and 1/30/04 have been considered and made of record.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1,3, 5-8,10,11, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Murai et al considered with Masuda et al and all further considered with Hioki et al.

The following analysis is made:

Claim 1 Murai et al

An optical data disc comprising:	See abstract, title and description of figs.
a first side and a second side,	3-6
each side including at least a first data layer,	
wherein data is arranged on the data layer of said first side along a first spiral oriented in a first direction when viewed on said first side, and data is arranged on the data layer of said second side along a second spiral oriented in a direction opposite that of said first spiral when viewed on said second side, so that a read head that is adjacent to one side can read the data thereon when the disc is rotated in one direction and when adjacent to the other side can read the data thereon when the disc is rotated in the other direction, and	
direction indicia disposed on at least one of said first and second sides, said direction indicia being machine readable and being indicative of the direction in which the disc must be rotated to allow data to be read from at least one side.	see secondary references - below

As analyzed above, the Murai et al system disclose an optical record having a first and second side, in which at least one recording layer is contained thereon. The desired "so that" phrase of claim 1 inherently follows.

With respect to the direction indicia – no such information is so contained.

The secondary references to Masuda et al and Hiroki et al discus the ability in this environment of providing for appropriate "control" indicia – signal/ that indicate which side is "up", or the first side. See the discussion with respect to element 94 in figure 2 and the discussion with respect to figure 3 respectively.

It would have been obvious to modify the base system of Murai et al and modify such with the above noted teachings so as to provide for appropriate "directional indicia" that is "machine readable". Such control information provides for an automatic playback of the media as desired.

The limitations of claims 1 and 7 are hence met.

With respect to claims 3 and 10, lead in area is provided. Because the indicium in Masuda et al is separate from such, this limitation is met.

With respect to claim 5 this refers to the data found on the record medium. Such data is present in the above references.

With respect to claims 6 and 8, such is met by the above combination of references.

With respect to claim 11, the special section is interpreted as that found in the secondary reference to Masuda et al.

With respect to claim 13 such is present.

2. Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claims 1 and 7 as stated in paragraph 1 above, and further in view of the acknowledge prior art of figure 1.

The limitations of claims 2 and 9 are drawn to the acknowledged prior art multi-layered media known.

The description of the acknowledged prior art recognizes the claimed limitations.

It would have been obvious to modify the above noted references to include such multiple layers, motivation is as acknowledged – providing increased data storage.

3. Claims 4, 12, 14-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over the art as applied to claim 7 as stated in paragraph 1 above, and further in view of Official notice.

With respect to claims 4 and 12, as interpreted, the above combined references provide for the ability of having an appropriate control signal – as recognized by the Hioki et al reference on each side of the record medium. As interpreted above, the special section is interpreted as that of the element 94 in Masuda et al.

As well known in this environment, the use of bar codes, and the BCA for appropriate control information is well known and Official notice is taken thereof.

The ability of using such well known techniques – BCA, bar codes, in the appropriate location – and designate such as a "third" spiral" is considered met by the above combined teachings.

With respect to the limitations of claim 14 such is met when the above references are relied upon.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 1-16 are provisionally rejected on the ground of nonstatutory double patenting over claim 27 of copending Application No. 10/716113, further considered with Official notice and further considered with Masuda et al. This is a provisional double patenting rejection since the conflicting claims have not yet been patented.

The subject matter claimed in the instant application is fully disclosed in the referenced copending application and would be covered by any patent granted on that copending application since the referenced copending application and the instant application are claiming common subject matter, as follows:

The copending claim 17 meets the limitations of the above independent claims 1,7 as well as the limitations of claims 5,6,8. The indicia of rotation are present.

With respect to the limitations of claims 2 and 9, such is acknowledged by the prior art.

With respect to claims 3 and 10, the lead-in areas are noted in the acknowledged prior art.

With respect to the limitation of claim 11, such is met by the special indicia, element 94 and the BCA, bar code, and placement of the special section is further obvious in view of the well known bca and bar code capability in this environment.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references to O'Hara et al, Ito et al and Kawamura et al can be relied upon in place of the base reference to Murai et al for discloses an optical record having the appropriate directional limitations.

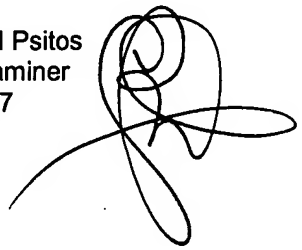
The Bartholet et al document is cited as illustrative of an alternative side/directional indicia teaching.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M. Psitos whose telephone number is (571) 272-7594. The examiner can normally be reached on M-F: 6:00 - 2:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dwayne D. Bost can be reached on (571) 272-7023. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Aristotelis M Psitos
Primary Examiner
Art Unit 2627



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